REMARKS

The Official Action of July 28, 2008 and the references cited therein have been carefully considered. The amendments and remarks herein are considered to be responsive thereto. Claims 1-16 have been canceled without canceling the subject matter thereof pursuant to the restriction requirement. Claims 17-19 remain in the case.

The Examiner indicates that the information disclosure statement filed March 16, 2005 fails to provide a copy of WO0038667 and English translated copies of JP2000-1472 and Belgian Patent 672,205. Enclosed are copies of WO0038667, US Pat. No. 3,404,178 (English equivalent of Belgian Patent 672,205) and the English abstract of JP2000-1472.

Claims 20, 21, 22 and 25 are objected to for various reasons. Claims 20 and 23 are rejected under 35 USC 101 for failing to set forth steps involved in the method/process. Finally, claims 20-25 are rejected under 35 USC 112, second paragraph, for lacking antecedent basis. However, the instant application as originally filed only contains 19 claims. The elected invention consists only of claims 17-19 which are directed to compounds for ocular diseases.

Claims 17-19, 21, 24, and 26 are rejected under 35 USC 103(a) as being unpatentable over WO01/46140 in view of WO02/24647. The Examiner states that WO01/46140 discloses E2 prostaglandins for preventing bone loss and WO02/24647 discloses agonists of the EP4 subtype useful in the prevention of bone loss, where the difference constitutes a carboxylic acid terminus to the alpha chain in place of the instantly claimed 1H-tetrazol-5-yl group. Claims 20, 22, 23, and 25 are rejected under 35 USC 103(a) as being unpatentable over WO01/46140 and WO02/24647 as applied to claims 17-19, 21, 24, and 26 as indicated above, and further in view of WO00/38667 and US6,344,477. The Examiner states that WO00/38667 describes the use of EP receptor agonists in combination with beta-blockers in the reduction of intraocular pressure and that US6344477 indicates that EP4 subtype receptor agonists are useful in the treatment of dry eye disorders. As indicated above, the instant invention consists of 19 claims (claims 1-19). Claims 1-16 are directed to the use of compounds in the treatment of glaucoma and/or ocular hypertension and were canceled pursuant to a two-way restriction requirement. Claims 17-19, directed to novel compounds, are the only remaining claims. The compounds of claims 17-19 are not indicated for prevention of bone loss. It appears that the Examiner may have inadvertently mixed the instant application with another. In any event, the compounds in claims 17-19 are not taught or suggested by the art cited by

the Examiner. Thus, the Examiner is respectfully requested to withdraw the 35 USC 101, 112, and 103 rejections.

In light of the amendments and remarks herein Applicants believe the claims are in condition for allowance. The Examiner is respectfully requested to contact the undersigned at the number below if this would expedite the allowance.

Respectfully submitted,

By: _____

Sylvia A. Ayler
Reg. No. 36,486
Attorney for Applicant(s)
MERCK & CO., INC.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-4909

Date: September 24, 2008